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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/988,181	12/10/1997	SHINICHI OSHIMA	Q48708	7161

7590 03/22/2002

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EXAMINER

GORDON, RAEANN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 03/22/2002

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 08/988,181
Filing Date: December 10, 1997
Appellant(s): Shinichi Oshima

Robert M. Masters
For Appellant

MAILED
MAR 21 2002
GROUP 3700

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed January 11, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit:

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 12-43 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Art Unit:

4,921,255	TAYLOR	5-1990
1,406,541	CONNELL	2-1922

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connell in view of Taylor. Connell discloses a box with pictures and written descriptions of the contents of the box. Although Connell discloses cigar information on the box a difference in what is attributed to printed matter does not provide a basis on which patentability may be predicted. Ex parte Breslow, 192 USPQ 431, U.S. Industries, Inc et al v. Ladd, 141 USPQ 376. Golf balls with different playing characteristics, as disclosed by Taylor, are usually sold in boxes having a cover. It would have been obvious for one skilled in the art to label a box with pictorial illustrations and descriptive text of each ball since such is a conventional technique for informing the golfer of the different golf balls.

Art Unit:

(11) *Response to Argument*

Appellant argues the primary reference, Connell, fails to teach or suggest a box providing information about various characteristics of pipes within a package. The Examiner disagrees. Connell clearly states 'a label in which the particular style or shape of a variety of styles of pipes and the name of the style of pipes packed in a given container may be ascertainable from a rapid inspection of the label'. Although the indicia or printed matter in the Connell patent pertains to pipes as oppose to golf balls, printed matter does not provide a basis for patentability. See *In re Gulack* 217 USPQ 401.

Appellant further argues that Connell merely provides general information concerning different types of pipes and the shapes. Connell states the labels reveal for example, whether the bit is ring or flush mounted, whether it is made out of rubber, horn, celluloid, amber, bakelite, or other material, or if the pipe is finished natural, Italian or otherwise (page 2, lines 80-98).

In regards to claim 30, Appellant argues a color-encoded identification mark is neither taught nor suggested in the prior art. Attention is directed to page 2, lines 103-110, which describes different color backgrounds for distinguishing different priced pipes. For example, a 25 cent pipe has a yellow background, a 50 cent pipe has a blue background, etc.

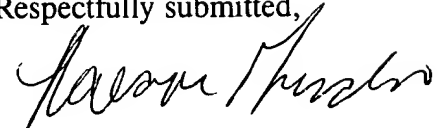
In regards to the Taylor reference, golf balls with different playing characteristics, as disclosed by Taylor, are usually sold in boxes having a cover. It would have been obvious for one skilled in the art to label a box with pictorial illustrations and descriptive text, as disclosed

Art Unit:


by Connell, of each ball or any other packaged item since such is a conventional technique for informing the consumer of the contents.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Raeann Gorden



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rg
March 20, 2002

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